



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) FS-F03215-01	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____		Application Number 10/730,143	Filed December 9, 2003
First Named Inventor Kouta Fukui		Examiner Thorl Chea	
Art Unit 1752		Examiner Thorl Chea	

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

<input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>34,474</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<div style="text-align: center;"> Signature Margaret A. Burke Typed or printed name (703)838-8013 Telephone number January 26, 2006 Date </div>
---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------	--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appl. No.: 10/730,143 Confirmation No. 5961
Applicant: Kouta Fukui
Filed: December 9, 2003
Title: PHOTOTHERMOGRAPHIC MATERIAL
Art Unit: 1752
Examiner: Thorl Chea
Docket No.: FS-F03215-01
Cust. No.: 37398

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant submits the following arguments in support of the Pre-appeal Brief Request for Review. Applicant submits that there is at least one legal deficiency in the rejections. The legal deficiency lies in the Examiner's failure to present a prima facie case of obviousness by failing to provide a reference to teach or suggest at least two elements of Applicant's invention.

A complete set of the pending claims can be found in the response to the Office action of March 23, 2005.

Claims 1, 3-5, and 8-10 were rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U.S. Patent No. 5,998,126 to Toya et al., U.S. Patent No. 4,332,889 to Siga et al., U.S. Patent No. 5,958,668 to Matsumoto et al., U.S. Patent No 4,211,839 to Suzuki et al., and EP 1096310.

U.S. Application Serial No. 10/730,143
Pre-Appeal Brief Request for Review

Claim 2 was rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U.S. Patent No. 5,998,126 to Toya et al., U.S. Patent No. 4,332,889 to Siga et al., U.S. Patent No. 5,958,668 to Matsumoto et al., U.S. Patent No. 4,211,839 to Suzuki et al., and EP 1096310 as applied to claims 1, 3-5, and 8-10 above and further in view of U.S. Patent No. 5,656,419 to Toya et al.

Claims 11-19 were rejected under 35 U.S.C. 103(a) over the combination of U.S. Patent No. 5,998,126 to Toya et al., U.S. Patent No. 4,332,889 to Siga et al., U.S. Patent No. 5,958,668 to Matsumoto et al., U.S. Patent No. 5,656,419 to Toya et al., and U.S. Patent No. 4,211,839 to Suzuki et al.

It is respectfully submitted that none of the above combinations of references renders any of the pending claims obvious. The invention of the present application is a photothermographic material which uses specific orthobisphenol reducing agents represented by formulas (R-1) and (R-2) together or (R-1) and (R-3) together. By using the specific orthobisphenol reducing agents of this invention together, a photothermographic material is obtained which exhibits an excellent silver image with both high sensitivity and pure black tone; such a material is not obtained using only the reducing agent represented by formula (R-1).

The effects of the use of specific orthobisphenol reducing agents together in this invention are shown in the photographic performance data in Table 1 of the specification. In Table 1, Experiments Nos. 5 and 6, each of which uses two kinds of specific orthobisphenol reducing agents together exhibit unexpectedly better color tone (pure black tone) while maintaining high sensitivity, compared to Experiment No. 4 which uses

U.S. Application Serial No. 10/730,143
Pre-Appeal Brief Request for Review

only one kind of reducing agent. Experiment Nos. 8 and 9, each of which uses two kinds of specific orthobisphenol reducing agents together, exhibit unexpectedly better sensitivity while maintaining pure black tone compared to Experiment No. 7 which uses only one kind of reducing agent.

Concerning the reference to Suzuki, the use of two reducing agents together is disclosed: 2,4-dialkyl substituted orthobisphenols and 2,6-dialkyl substituted parabisphenols. This does not teach or suggest the use of the combined orthobisphenols of the present invention.

Further, there is no teaching or suggestion to combine the references to obtain the combination of a silver iodide-based photothermographic material with the specific combination of orthobisphenols of the present invention. Instead, it is respectfully submitted that the Examiner has used impermissible hindsight to "pick and choose" individual components of the claimed invention from a wide variety of references in order to "recreate" the claimed invention. Thus it is submitted that a prima facie case of obviousness has not been made.


Concerning claims 11-19, there is no teaching or suggestion to combine a high silver iodide-based photothermographic material with the specific reducing agent of formula R-5 and the antifoggant of formula H in the claimed ratio. Thus it is submitted that a prima facie case of obviousness has not been made.

U.S. Application Serial No. 10/730,143
Pre-Appeal Brief Request for Review

In view of the foregoing remarks, it is respectfully submitted that a prima facie case of obviousness has not been made and all of the claims currently pending in the application are in condition for allowance. Early and favorable action is respectfully requested.

Respectfully submitted,

TAIYO, NAKAJIMA & KATO
401 Holland Lane #407
Alexandria, VA 22314
Telephone: (703)838-8013
Date: January 25, 2006


Margaret A. Burke
Registration No. 34,474